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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,485	05/10/1999	STEPHEN CHIN	LNC314/97	4894

7590 12/19/2001

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/307,485

Applicant(s)

CHIN, STEPHEN

Examiner

Jeffrey C Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/01/01 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by *Mersky et al.* (US 6,119,106)

Mersky teaches a method of purchasing a money order via the Internet (col.11, lines 15-25; claims 12 and 15), comprising the steps of:

providing a money order system capable of generating money orders;

contacting the money order system via the Internet by a user desiring to purchase a money order in a predefined amount;

transmitting information to the money order system via the Internet required to purchase the money order, the information including user's identification, an intended receiver identification, and financial amount of the money order;

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generating a money order from the system upon receipt of the transmitted information;

sending the generated money order to the intended receiver;

generating an e-mail message to at least one of the user or intended receiver of the money order that the money has been sent to the intended receiver (col.3, lines 9-34);

transmitting credit card information associated with the user and electronically processing the credit card information to make available funds needed for the purchase of the money order by the user (col.2, lines 12-16; col.12, line 17);and

electronically deducting a predetermined amount of funds from the account in accordance with the amount of funds required to generate the user purchased money order (col. 11, lines 15-30 and col.12, line 15-23).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mersky* in view of *Barzilai et al.* (6,012,045).

Mersky further teaches a method of purchasing a money order via the Internet for the purchase of goods from any Internet-based transactions substantially as claimed (see abstract; col.2, line 12-43; claim 1-28) including:

contacting an Internet site for the money order system via the Internet by the buyer after the bid is awarded to the buyer;

transmitting information to the money order system via the Internet by the buyer to purchase the money order for the sale;

generating a money order upon receipt of the transmitted information from the buyer (claims 12-14);

delivering from money order system the money order to the seller; and

delivering the goods from the seller to buyer after money order being generated.

Mersky fails to teach an auction transaction which awards a bid to a buyer for goods purchased from a seller via an Internet auction site.

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Barzilai is applied for showing that it is conventional to perform electronic payment on online bidding, sales, and auctions over the Internet (see claims 1, 15 and 20).

In view of *Barzilai*, it would have been obvious to a person having ordinary skill in the art to perform an online auction to use *Mersky*'s money order system for a secure business transaction and efficient processing of payments.

Response to Arguments

5. Applicant's arguments filed 10/1/2001 have been fully considered but they are not persuasive.

Applicant argues that Mersky et al. does not show "contacting the money order system via the Internet by a user desiring to purchase a money order in a predetermined amount", in contrast to the applicant's argument, Mersky et al. disclose a method and apparatus for enabling customers to "facilitate customer payment to creditors with various forms of payment (e.g., check, cash, credit card, etc.) from a remote site (e.g., a local retail establishment)... Each agent computer system transmits their daily transaction information to the host computer system at a predetermined time, preferably

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the closing time for the business at the respective remote site. The host system receives the transaction information from each agent system and sorts the information to create a transaction report for each creditor affiliated or under contract with the service provider. Once the transaction reports are generated, the reports are transmitted to the appropriate creditor computer systems in order to credit customer payments to the corresponding customer accounts. Alternatively, the host computer system may generate transaction reports for each creditor affiliated with the service provider, and send the reports to the creditors in any conventional manner (e.g., facsimile, ground transport mail, etc.). Creditors may use the reports to apply the customer payments to the appropriate customer accounts in any conventional manner (e.g., enter the payments into the creditor computer system). The system operator or service provider receives funds from each of the agents and pays each of the creditors via electronic fund transfer or other conventional payment form. The host system generates a closeout report containing transaction information for all transactions occurring at the respective remote sites. The report is typically printed at a predetermined time after all the transaction information has been received from the remote computer systems.

The present invention may be additionally utilized for other applications,

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such as purchasing money orders or telephone cards (e.g., pre-paid cards enabling the card holder to place telephone calls incurring fees up to the pre-paid amount), in substantially the same manner described above except that each of the remote computer systems includes a peripheral printer or other device to generate the money orders or telephone cards, respectively, and the transaction reports are sent to the respective money order or telephone companies.” (col. 2, line 12-col. 3, line 35)

Applicant also argue that “a combination of Mersky et al. and Barzilai et al. is not proper” because the combination of Mersky et al. and Barzilai et al. would not result in the claimed system. The examiner disagrees. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Mersky et al. discloses the use of money order system via host computers or Internet for payment or financial transactions. It is well known that financial transactions are commonly conducted via the Internet for paying online auction bids as evidenced from Brazilai et al. Therefore, it would clearly obvious to one of ordinary

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skill in the art to use money order system of Mersky et al. to pay all known online financial transactions including online auction bids.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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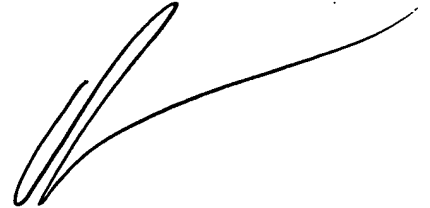
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeffrey Pwu, whose telephone number is (703) 308-7835.

Jeffrey Pwu



Dec 16, 2001



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100